UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,104	03/31/2004	Paul Buchheit	Google-74 (GP-282-00-US)	5182

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EXAMINER
LASTRA, DANIEL

ART UNIT	PAPER NUMBER
3688	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 November 2009*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *See Continuation Sheet* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6, 8, 10-12, 15-18, 34-38, 40-42, 45-52, 54, 56-58, 61-64, 80-88 and 91-94* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

Continuation of Disposition of Claims: Claims pending in the application are 1-6,8,10-12,15-18,34-38,40-42,45-52,54,56-58,61-64,80-88 and 91-94.

DETAILED ACTION

1.   Claims 1-6, 8, 10-12, 15-18, 34-38, 40-42, 45-52, 54, 56-58, 61-64, 80-88 and

91-94 have been examined. Application 10/814,104 (RENDERING CONTENT-

TARGETED ADS WITH E-MAIL) has a filing date 03/31/2004.

Response to Amendment

2.   In response to Non Final Rejection filed 08/03/09, the Applicant filed an

Amendment on 11/03/09, which amended claims 1-6, 10, 34, 37, 40-41, 45, 47-52, 54,

56, 80, 83, 86, cancel claims 7, 9, 13, 14, 19-33, 43, 44, 53, 55, 59-60, 65-75, 89-90

and added new claims 93-94.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-6, 8, 10-12, 15-18, 34-38, 40-42, 45-52, 54, 56-58, 61-64, 80-88 and

91-94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Werkhoven (WO

02/25507) in view of Lazaridis (US 2003/0026231).

Claims 1, 34, 40, 45, 47, 80, 86 and 91, Werkhoven teaches:

A computer-implemented method for facilitating the serving of advertisements

with e-mail content, the method comprising:

a) accepting, by a web-based e-mail serving system including at least one computer, an e-mail request for a document: including e-mail content (see page 3, lines 10-15)

b) generating, by the web-based e-mail serving system, request identifier (see page 3, lines 10-15);

c) serving to a client device, by the web-based e-mail serving system, the requested document in association with the request identifier (see page 3, lines 10-15);

g) storing, by the web-based e-mail serving system, the received at least one ad *in association with the request identifier* (see page 3, lines 30-35);

h) accepting, by the web-based e-mail serving system, a *second* ad request from the client device *the second ad request including the request identifier* (see page 3, lines 30-35);

i) reading, by the web-based e-mail serving system, the stored at least one ad using the *request identifier included in the second* ad request (see page 3, lines 30-35); and

j) serving to the client device, by the web-based e-mail serving system, the at least on ad read (see page 3, lines 30-35).

Werkhoven does not teach:

d) generating, by the web-based e-mail serving system, a first ad request for at least one ad

relevant   to   the   e-mail   content,   the   first   ad   request

including   information   of   the   e-mail   content   and   the

request   identifier;   e)   transmitting,   by   the   web-based   e-mail   serving

system, the first ad request to a content-relevant ad serving system; f) receiving,

responsive to the transmitted first ad request and by the web-based e-mail serving

system,   at   least   one   ad   relevant   to   the   e-mail

content *in association with the request identifier from the content-relevant ad serving

system.* However, Lazaridis teaches that it is old and well known in the promotion art at

the time the application was made, to know to transmit to users email messages

combine with advertisements (see paragraph 15-16), where said advertisement are

related to the content of said messages (see paragraph 21) and where said messages

and advertisements are transmitted to said user using a Proxy Content Server (see

figure 1, item 18). Lazaridis teaches that the Proxy Content Server serves as an

intermediary between ad and content servers (see figure 1, items 10 a,b,c) and client

devices (see fig 1 item 24), where said ad and content servers communicate with said

Proxy Content Server using an intranet (see paragraph 29, figure 2), therefore, client

devices (see figure 2, item 24) interact directly with the Proxy Content Server but not

with the ad and content servers. Lazaridis also teaches that client devices make web

request for messages to Proxy Content Server (see paragraph 50),where Proxy Content

Server response to said request by transmitting to said client devices information stored

in Proxy Content Server's database or poll to said database from updated information

from ad and content server (see paragraph 54). Therefore, it would have been obvious

to a person of ordinary skill in the art at the time the application was made, to know that Werkhoven would modify his invention to include the Lazaridis' Proxy content Server to push advertisements to a user via electronic mail, the Proxy Content Server arranged to detect opening of an electronic mail and in response thereto to provide push content material to a client device to be displayed within a pop-up window arranged to appear a predetermined time after the user has begun viewing the electronic mail in order that the Proxy Content Server serves as an intermediary between client devices and ad and content servers so ad and content servers are not accessible to client devices on the Internet and in view that the claimed invention is a combination of old elements and in the combination each element would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claims 2 and 48, Werkhoven teaches:

wherein the *second* ad request from the client device is generated automatically, without a manual input from a user of the client device (see page 3, lines 10-15).

Claims 3 and 49, Werkhoven teaches:

wherein the *second* ad request was sourced by the client device when it rendered the requested document (see page 3, lines 101-15).

Claims 4 and 50, Werkhoven teaches:

wherein the *second* ad request was sourced by a client device after it rendered the requested document (see page 2, lines 30-37).

Claims 5 and 51, <u>Werkhoven</u> teaches:

wherein the *second* ad request was sourced by a browser when it rendered the requested document (see page 3, lines 10-15).

Claims 6 and 52, <u>Werkhoven</u> teaches:

wherein the *second* ad request was sourced by a browser after it rendered the requested document (see page 2, lines 20-37).

Claims 8 and 54, <u>Werkhoven</u> teaches:

wherein the request identifier may be used as a primary key to lookup the associated at least one ad (see page 3, lines 30-37).

Claims 10 and 56, <u>Werkhoven</u> teaches:

wherein the act of reading the stored at least one ad using information from the *second* ad request uses the request identifier to lookup the associated at least one ad (see page 3, lines 30-37).

Claims 11 and 57, <u>Werkhoven</u> teaches:

wherein the act of serving the requested document in association with the request identifier is performed by a first thread, and wherein the act of obtaining at least one ad relevant to content of the e-mail is performed by a second thread (see page 3, lines 1-5).

Claims 12 and 58, <u>Werkhoven</u> teaches:

wherein the execution of the first thread is independent of the execution of the second thread (see page 2, lines 35-37).

Claims 15 and 61, <u>Werkhoven</u> teaches:

wherein the document including e-mail content represents an individual e-mail message (see page 6, lines 10-25).

Claims 16 and 62, <u>Werkhoven</u> teaches:

wherein the document including e-mail content represents a group of e-mail messages (see page 6, lines 1-10).

Claims 17 and 63, <u>Werkhoven</u> teaches:

wherein the document including e-mail content represents an e-mail thread output as a conversation (see page 9, lines 1-15).

Claims 18 and 64, <u>Werkhoven</u> teaches:

wherein the document including e-mail content is a conversation view including a group of e-mails (see page 9, lines 1-15).

Claims 35 and 81, <u>Werkhoven</u> teaches:

wherein the at least one additional content item is selected from a group consisting of (a) a news article, (b) an excerpt of a news article, (c) a search query, (d) a product review, and (e) an excerpt of a product review (see page 9, lines 1-30).

Claims 36 and 82, <u>Werkhoven</u> teaches:

herein the at least one additional content item includes at least one content relevant ad and at least one further additional content item selected from a group consisting of (a) a news article, (b) an excerpt of a news article, (c) a search query, (d) a product review, and (e) an excerpt of a product review (see page 9, lines 1-10).

Claims 37 and 83, <u>Werkhoven</u> teaches:

Wherein the another additional content item request from the client device is generated automatically, without a manual input from a user of the client device (see page 2, lines 25-30).

Claims 38 and 84, Werkhoven teaches:

wherein the at least one additional content item is selected from a group consisting of (a) a news article, (b) an excerpt of a news article, (c) a search query, (d) a product review, and (e) an excerpt of a product review (see page 9, lines 1-10).

Claim 46 Werkhoven teaches:

wherein the electronic messaging content is content from one of (A) on-line groups, (B) blogs, (C) message postings, and (D) instant messaging (see paragraph 2) (see page 9, lines 1-10).

Claim 85, Werkhoven teaches:

wherein the at least one additional content item includes at least one content relevant ad and at least one further additional content item selected from a group consisting of (a) a news article, (b) an excerpt of a news article, (c) a search query, (d) a product review, and (e) an excerpt of a product review (see page 9, lines 1-10).

Claims 41 and 87, Werkhoven teaches:

Wherein the *second* ad request from the client device is generated automatically, without a manual input from a user of the client device (see page 2, lines 25-30).

Claims 42 and 88, Werkhoven teaches:

wherein the electronic messaging content is content from one of (A) on-line groups, (B) blogs, (C) message postings, and (D) instant messaging (see page 9, lines 1-10).

Claim 92 <u>Werkhoven</u> teaches:

wherein the electronic messaging content is content from one of (A) on-line groups, (B) blogs, (C) message postings, and (D) instant messaging (see page 9, lines 1-10).

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 93-94 are rejected under 35 U.S.C. 102(b) as being anticipated by <u>Werkhoven</u> (WO 02/25507).

Claims 93-94, <u>Werkhoven</u> teaches:

A computer-implemented method for facilitating the serving of advertisements with e-mail content, the method comprising:

a)   accepting,   by   a   web-based   e-mail   serving   system including   at   least   one   computer,   an   e-mail   request   for a document including e-mail content (see page 3, lines 1-37);

b)   generating,   by   the   web-based   e-mail   serving system, a request identifier (see page 3, lines 1-37);

c) serving to a client device, by the web-based e-mail serving system, the requested document in association with the request identifier (see page 3, lines 1-37);

d) obtaining, by the web-based e-mail serving system, at least one ad relevant to the e-mail content, the at least one ad having been determined automatically using at least some of the e-mail content (see page 3, lines 1-37);

e) storing, by the web-based e-mail serving system, the obtained at least one ad(see page 3, lines 1-37);

f) receiving, by the web-based e-mail serving system, a second ad request from the client device (see page 3, lines 1-37);

g) reading, by the web-based e-mail serving system, the stored at least one ad using information from the second ad request (see page 3, lines 1-37); and

h) serving to the client device, by the web-based e-mail serving system, the at least one ad read (see page 3, lines 1-37).

Response to Arguments

5.   Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.   Accordingly, **THIS ACTION IS MADE FINAL**.   See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-

6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, ROBERT A WEINHARDT can be reached on (571)272-6633. The

official Fax number is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DANIEL LASTRA/
Primary Examiner, Art Unit 3688